



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/658,902

09/10/2003

Sundararajan Sriram

TI-28564.1

3595

23494

7590

06/13/2006

TEXAS INSTRUMENTS INCORPORATED

P O BOX 655474, M/S 3999

DALLAS, TX 75265

EXAMINER

RAMOS FELICIANO, ELISEO

ART UNIT

PAPER NUMBER

2617

DATE MAILED: 06/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/658,902

Applicant(s)

SRIRAM, SUNDARARAJAN

Examiner

Eliseo Ramos-Feliciano

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 August 2005; 22 March 2006 (RCE).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 13-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 13-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2617

DETAILED ACTION

Art Unit – Notice

1. The Art Unit location of your application in the USPTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Art Unit 2617.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 29, 2005 (RCE request filed March 22, 2006) has been entered.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. **Claims 1-5 and 13-17** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1 and 13 now require “each of said primary, secondary and tertiary synchronization codes being independently generated”. This is subject matter which was not described in the original specification; therefore, new matter. Neither Applicant has pointed out where in the original specification support for the subject addition can be found.

Claims 2-5 and 14-17 depend from *claims 1 and 13*; therefore, they contain same issues as explained above.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Issue I: U.S. Patent No. 6,665,277

6. **Claims 1-5 and 13-17** are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims (applied below) of U.S. Patent No. 6,665,277 (simply “6,665,277” hereinbelow). Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following.

Regarding **claim 1**, claim 1 of U.S. Patent No. 6,665,277 discloses a method, comprising the steps of:

Art Unit: 2617

- receiving a frame of data having a predetermined number of time slots (column 6, lines 29-31);
- receiving a plurality of data symbols in each respective time slot (column 6, lines 33-34); and
- receiving each of a primary, a secondary and a tertiary synchronization code in each said predetermined number of time slots (column 6, lines 35-37).

In addition, claim 1 of 6,665,277 is more specific than claim 1 of present application. Conflicting claims in the instant application are not patentably distinct because conflicting claims are broader and generic with respect to the applied reference claims, i.e., an obvious variation. Many decisions support the fact that a broad or generic claim is obvious from a specific claim, i.e., an obvious variation. See *In re Van Ornum and Stang*, 214 USPQ 761 (CCPA 1982); *In re Goodman* (CA FC) 29 USPQ2d 2010 (12/3/1993); *In re Vogel and Vogel*, 164 USPQ 619 (CCPA 1970); *In re Berg* (CA FC) 46 USPQ2d 1226 (3/30/1998); *Eli Lilly and Co. v. Barr Laboratories Inc.*, 58 USPQ2d 1865 (CA FC 2001). It is well settled that omission of an element and its function in a combination is an obvious expedient if the remaining elements perform the same functions as before. This notion is supported by *In re KARLSON*, 136 USPQ 184 (1963); *In re Nelson*, 95 USPQ 82 (CCPA 1952); and *In re Eliot*, 25 USPQ 111 (CCPA 1935).

Regarding **claims 2-5**, claim 1 of 6,665,277 discloses everything claimed as applied above. In addition, claims 3-6 of 6,665,277, respectively, disclose every single feature further claimed (see column 6, line 64 to column 7, line 8).

Regarding **claim 13**, claim 8 of U.S. Patent No. 6,665,277 discloses a method, comprising the steps of:

- transmitting a frame of data having a predetermined number of time slots (col. 7, lines 23-24);
- transmitting a plurality of data symbols in each of said time slots (col. 7, lines 26-27); and

Art Unit: 2617

- transmitting a primary, a secondary and a tertiary synchronization code in each of said time slots (col. 7, lines 28-30).

In addition, claim 8 of 6,665,277 is more specific than claim 13 of present application. Conflicting claims in the instant application are not patentably distinct because conflicting claims are broader and generic with respect to the applied reference claims, i.e., an obvious variation. Many decisions support the fact that a broad or generic claim is obvious from a specific claim, i.e., an obvious variation. See *In re Van Ornum and Stang*, 214 USPQ 761 (CCPA 1982); *In re Goodman* (CA FC) 29 USPQ2d 2010 (12/3/1993); *In re Vogel and Vogel*, 164 USPQ 619 (CCPA 1970); *In re Berg* (CA FC) 46 USPQ2d 1226 (3/30/1998); *Eli Lilly and Co. v. Barr Laboratories Inc.*, 58 USPQ2d 1865 (CA FC 2001). It is well settled that omission of an element and its function in a combination is an obvious expedient if the remaining elements perform the same functions as before. This notion is supported by *In re KARLSON*, 136 USPQ 184 (1963); *In re Nelson*, 95 USPQ 82 (CCPA 1952); and *In re Eliot*, 25 USPQ 111 (CCPA 1935).

Regarding **claims 14-17**, claim 8 of 6,665,277 discloses everything claimed as applied above. However, it fails to specify the further steps required by claims 14-17 of present application.

Claim 9 of 6,665,277 teaches an analogous method to the one of claim 8 of 6,665,277. Claims 10-13 of 6,665,277, respectively, disclose every single feature further claimed by claims 14-17 of present application (see column 8, lines 16-27).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify claim 8 of 6,665,277 with the teachings of claims 10-13 of

6,665,277, respectively, to include the further steps required by claims 14-17 of present application because they are suggested by the same set of claims of U.S. Patent No. 6,665,277.

Issue II: copending Application No. 10/606,816

7. **Claims 1-5 and 13-17** are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of copending Application No. 10/606,816 (simply “10/606,816” hereinbelow). Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following.

Regarding **claim 1**, claim 1 of copending Application No. 10/606,816 discloses a method, comprising the steps of:

- receiving a frame of data having a predetermined number of time slots;
- receiving a plurality of data symbols in each respective time slot; and
- receiving each of a primary, a secondary and a tertiary synchronization code in each said predetermined number of time slots.

Conflicting claims in the instant application are not patentably distinct because conflicting claims are broader and generic with respect to the applied reference claims, i.e., an obvious variation. Many decisions support the fact that a broad or generic claim is obvious from a specific claim, i.e., an obvious variation. See *In re Van Ornum and Stang*, 214 USPQ 761 (CCPA 1982); *In re Goodman* (CA FC) 29 USPQ2d 2010 (12/3/1993); *In re Vogel and Vogel*, 164 USPQ 619 (CCPA 1970); *In re Berg* (CA FC) 46 USPQ2d 1226 (3/30/1998); *Eli Lilly and Co. v. Barr Laboratories Inc.*, 58 USPQ2d 1865 (CA FC 2001). It is well settled that omission of an element and its function in a combination is an obvious expedient if the remaining elements

Art Unit: 2617

perform the same functions as before. This notion is supported by *In re KARLSON*, 136 USPQ 184 (1963); *In re Nelson*, 95 USPQ 82 (CCPA 1952); and *In re Eliot*, 25 USPQ 111 (CCPA 1935).

Regarding **claims 2-5**, claim 1 of 10/606,816 discloses everything claimed as applied above. In addition, claims 2-5 of 10/606,816, respectively, disclose every single feature further claimed.

Regarding **claim 13**, claim 13 of copending Application No. 10/606,816 discloses a method, comprising the steps of:

- transmitting a frame of data having a predetermined number of time slots;
- transmitting a plurality of data symbols in each of said time slots; and
- transmitting a primary, a secondary and a tertiary synchronization code in each of said time slots.

Conflicting claims in the instant application are not patentably distinct because conflicting claims are broader and generic with respect to the applied reference claims, i.e., an obvious variation. Many decisions support the fact that a broad or generic claim is obvious from a specific claim, i.e., an obvious variation. See *In re Van Ornum and Stang*, 214 USPQ 761 (CCPA 1982); *In re Goodman* (CA FC) 29 USPQ2d 2010 (12/3/1993); *In re Vogel and Vogel*, 164 USPQ 619 (CCPA 1970); *In re Berg* (CA FC) 46 USPQ2d 1226 (3/30/1998); *Eli Lilly and Co. v. Barr Laboratories Inc.*, 58 USPQ2d 1865 (CA FC 2001). It is well settled that omission of an element and its function in a combination is an obvious expedient if the remaining elements perform the same functions as before. This notion is supported by *In re KARLSON*, 136 USPQ

Art Unit: 2617

184 (1963); In re Nelson, 95 USPQ 82 (CCPA 1952); and In re Eliot, 25 USPQ 111 (CCPA 1935).

Regarding **claims 14-17**, claim 13 of 10/606,816 discloses everything claimed as applied above. In addition, claims 14-17 of 10/606,816, respectively, disclose every single feature further claimed.

8. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. **Claims 1-4 and 13-16** are rejected under 35 U.S.C. 102(e) as being anticipated by Nyström et al. (US Patent Number 6,185,244).

Regarding **claim 1**, Nyström et al. discloses a method including the steps of:

receiving a frame (Figure 16) of data having a predetermined number of time slots (Slot 0 to Slot 15 – Figure 16);

receiving a plurality of data symbols (column 12, lines 14-15; column 2, line 3) in each respective time slot; and

receiving each of a primary (STI), a secondary (LCI) and a tertiary (FTI) synchronization code in each said predetermined number of time slots (Figure 18), each of said primary,

Art Unit: 2617

secondary and tertiary synchronization codes being independently generated (the codes are independently generated as claimed because they do not depend from each other, they are separate and distinct, and because they are separately generated).

For clarity, to further facilitate understanding of the present rejection, should be noted that the primary (STI), a secondary (LCI) and a tertiary (FTI) synchronization codes are included in Nyström et al.'s PSC and SSC (as depicted in Figure 18), which in turn are included in each time slot (column 12, line 10-12). The PSC and SSC are separate of other chips (data symbols as claimed – column 2, line 3) also included in each time slot (column 12, lines 14-15). The same frame that is transmitted (column 7, lines 13-20) is also received by a receiver (column 7, lines 21-27). Therefore, Nyström et al. discloses both receiving and corresponding transmitting steps.

Regarding **claims 2 and 3**, Nyström et al. discloses everything claimed as applied above (see *claim 1*). In addition, Nyström et al. discloses that the secondary (LCI) and the tertiary (FTI) synchronization codes identify a subset of codes (valid sequences); the secondary (LCI) and tertiary (FTI) synchronization codes are formed from a predetermined order (binary) of synchronization code elements (bits), the predetermined order corresponding to the subset of codes (valid sequences). See column 12, lines 28-51.

For clarity, to further facilitate understanding of the present rejection, the secondary (LCI) and a tertiary (FTI) synchronization codes are contained in the SSC. I.e., the SSC includes the combination of “the secondary and the tertiary synchronization codes” which in turn perform the same functions as claimed.

Regarding **claim 4**, Nyström et al. discloses everything claimed as applied above (see *claim 1*). In addition, Nyström et al. discloses that the secondary (LCI) and tertiary (FTI)

synchronization codes are formed from a predetermined order (binary) of common synchronization code elements (bits). See column 12, lines 28-51.

For clarity, to further facilitate understanding of the present rejection, the secondary (LCI) and a tertiary (FTI) synchronization codes are contained in the SSC. I.e., the SSC includes the combination of “the secondary and the tertiary synchronization codes” which in turn perform the same functions as claimed. In addition, binary order by definition (inherently) includes two types of code elements (bits) which are common; therefore, “common synchronization code elements” is met by Nyström et al. as claimed.

Regarding **claim 13**, Nyström et al. discloses a method including the steps of:

transmitting a frame (Figure 16) of data having a predetermined number of time slots (Slot 0 to Slot 15 – Figure 16);

transmitting a plurality of data symbols (column 12, lines 14-15; column 2, line 3) in each of said time slots; and

transmitting a primary (STI), a secondary (LCI) and a tertiary (FTI) synchronization code in each of said time slots (Figure 18) , each of said primary, secondary and tertiary synchronization codes being independently generated (the codes are independently generated as claimed because they do not depend from each other, they are separate and distinct, and because they are separately generated).

For clarity, to further facilitate understanding of the present rejection, should be noted that the primary (STI), a secondary (LCI) and a tertiary (FTI) synchronization codes are included in Nyström et al.’s PSC and SSC (as depicted in Figure 18), which in turn are included in each time slot (column 12, line 10-12). The PSC and SSC are separate of other chips (data symbols as

Art Unit: 2617

claimed – column 2, line 3) also included in each time slot (column 12, lines 14-15). The same frame that is transmitted (column 7, lines 13-20) is also received by a receiver (column 7, lines 21-27). Therefore, Nyström et al. discloses both receiving and corresponding transmitting steps.

Regarding **claims 14 and 15**, Nyström et al. discloses everything claimed as applied above (see *claim 1*). In addition, Nyström et al. discloses that the secondary (LCI) and the tertiary (FTI) synchronization codes identify a subset of codes (valid sequences); the secondary (LCI) and tertiary (FTI) synchronization codes are formed from a predetermined order (binary) of synchronization code elements (bits), the predetermined order corresponding to the subset of codes (valid sequences). See column 12, lines 28-51.

For clarity, to further facilitate understanding of the present rejection, the secondary (LCI) and a tertiary (FTI) synchronization codes are contained in the SSC. I.e., the SSC includes the combination of “the secondary and the tertiary synchronization codes” which in turn perform the same functions as claimed.

Regarding **claim 16**, Nyström et al. discloses everything claimed as applied above (see *claim 1*). In addition, Nyström et al. discloses that the secondary (LCI) and tertiary (FTI) synchronization codes are formed from a predetermined order (binary) of common synchronization code elements (bits). See column 12, lines 28-51.

For clarity, to further facilitate understanding of the present rejection, the secondary (LCI) and a tertiary (FTI) synchronization codes are contained in the SSC. I.e., the SSC includes the combination of “the secondary and the tertiary synchronization codes” which in turn perform the same functions as claimed. In addition, binary order by definition (inherently) includes two

Art Unit: 2617

types of code elements (bits) which are common; therefore, “common synchronization code elements” is met by Nyström et al. as claimed.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. **Claims 5 and 17** are rejected under 35 U.S.C. 103(a) as being unpatentable over Nyström et al. (US Patent Number 6,185,244).

Regarding **claim 5**, Nyström et al. discloses everything claimed as applied above (see *claim 1*). In addition, Nyström et al. teaches that the FTI (tertiary synchronization code) is used for frame timing by a mobile receiver. (Column 11, lines 58-63). However, Nyström et al. fails to teach that the mobile receiver identifies a first time slot of the frame by the FTI (tertiary synchronization code) in the same embodiment just explained.

In a separate embodiment, but still in the same field of endeavor, Nyström et al. teaches that with frame timing information the mobile receiver (mobile station) is able to locate the boundary of the frame, that is, a first time slot. (Column 4, lines 38-52).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Nyström et al. so that the a mobile receiver can identify the first time slot of the frame by the tertiary synchronization code, because such technique is suggested by the same Nyström et al. as explained above, and it provides for more reliable communications.

Regarding **claim 17**, Nyström et al. discloses everything claimed as applied above (see *claim 13*). In addition, Nyström et al. teaches that the FTI (tertiary synchronization code) is used for frame timing by a mobile receiver. (Column 11, lines 58-63). However, Nyström et al. fails to teach the tertiary synchronization code order corresponds to an order of time slots in the frame in the same embodiment just explained.

In a separate embodiment, but still in the same field of endeavor, Nyström et al. teaches that with frame timing information the mobile receiver (mobile station) is able to locate the boundary of the frame, which corresponds to an order of the time slots. (Column 4, lines 38-52).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Nyström et al. so that the tertiary synchronization code order corresponds to an order of time slots in the frame, because such technique is suggested by the same Nyström et al. as explained above, and it provides for more reliable communications.

Response to Arguments

13. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Even though arguments are moot as indicated above, for clarification of the record the following remarks are made.

14. With respect to the double-patenting rejection presented before and repeated hereinabove, Applicant argues that In re KARLSON, 136 USPQ 184 (1963) “is inapplicable since the law was changed subsequent to that decision” (see page 4 of the response).

In response, Applicant has not shown evidence in support to this allegation; consequently, no weight can be given to that contention.

Nevertheless, regardless of In re KARLSON applicability, the question is whether or not the conflicting claims are patentably distinct, or obvious. Applicant has not presented any reasoning as to why the conflicting claims would not be patentably distinct or obvious variation.

Conflicting claims in the instant application are not patentably distinct because conflicting claims are broader and generic with respect to the applied reference claims, i.e., an obvious variation. Many decisions support the fact that a broad or generic claim is obvious from a specific claim, i.e., an obvious variation. See In re Van Ornum and Stang, 214 USPQ 761 (CCPA 1982); In re Goodman (CA FC) 29 USPQ2d 2010 (12/3/1993); In re Vogel and Vogel, 164 USPQ 619 (CCPA 1970); In re Berg (CA FC) 46 USPQ2d 1226 (3/30/1998); Eli Lilly and Co. v. Barr Laboratories Inc., 58 USPQ2d 1865 (CA FC 2001). It is well settled that omission of an element and its function in a combination is an obvious expedient if the remaining elements perform the same functions as before. This notion is not only supported by In re KARLSON, 136 USPQ 184 (1963), but also In re Nelson, 95 USPQ 82 (CCPA 1952); In re Eliot, 25 USPQ 111 (CCPA 1935).

15. With respect to the double-patenting rejection presented before and repeated hereinabove, Applicant argues that “there is otherwise no issue since this application in its present form will not extend the monopoly of Patent No. 6,665,277” and that “the enforceability of the subject application will expire concurrently with the cited patent” (see page 4 of the response).

In response, the doctrine of double patenting seeks to prevent not only the problem of the unjustified extension of patent exclusivity beyond the term of a patent but also the problem of dual ownership of patents to patentably indistinct inventions. See MPEP 804 and 804.02.

Art Unit: 2617

Applicant is cautioned that reliance upon a concurrent expiration date cannot effectively substitute for the filing of one or more terminal disclaimers in order to overcome a proper double patenting rejection, particularly since a concurrent expiration date alone does not avoid the potential problem of dual ownership of patents to patentably indistinct inventions.

16. Applicant's arguments are generally directed to the newly added limitations (see page 5 of the response). In response, these limitations have now been treated on the merits. A detailed explanation can be found above. In addition, arguments regarding "independently generated" limitation are not persuasive because in contrast to Applicant allegations the claims fail to specifically and distinctively claim independent "from what?".

Conclusion

17. Any inquiry concerning this communication from the examiner should be directed to Eliseo Ramos-Feliciano whose telephone number is 571-272-7925. The examiner can normally be reached from 8:00 a.m. to 5:30 p.m. on 5-4/9 1st Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold, can be reached on (571) 272-7905. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



ELISEO RAMOS-FELICIANO
PRIMARY EXAMINER

ERF/erf

June 9, 2006